

TRANSMITTAL FORM

Attorney Docket No.

T00323
1906P

In re the application GIBSON

Confirmation: 8208

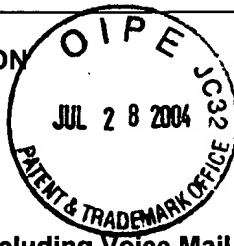
Serial No: 09/741,244

Group Art Unit: 2645

Filed: December 19, 2000

Examiner: Elahee, MD S.

For: Telephone System Including Voice Mail Screening



ENCLOSURES (check all that apply)

<input type="checkbox"/>	Amendment/Reply	<input type="checkbox"/>	Assignment and Recordation Cover Sheet	<input type="checkbox"/>	After Allowance Communication to Group
<input type="checkbox"/>	After Final	<input type="checkbox"/>	Part B-Issue Fee Transmittal	<input type="checkbox"/>	Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/>	Information disclosure statement	<input type="checkbox"/>	Letter to Draftsman	<input checked="" type="checkbox"/>	Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/>	Form 1449	<input type="checkbox"/>	Drawings	<input type="checkbox"/>	Status Letter
<input type="checkbox"/>	(X) Copies of References	<input type="checkbox"/>	Petition	<input checked="" type="checkbox"/>	Postcard
<input type="checkbox"/>	Extension of Time Request *	<input type="checkbox"/>	Fee Address Indication Form	<input type="checkbox"/>	Other Enclosure(s) (please identify below):
<input type="checkbox"/>	Express Abandonment	<input type="checkbox"/>	Terminal Disclaimer		
<input type="checkbox"/>	Certified Copy of Priority Doc	<input type="checkbox"/>	Power of Attorney and Revocation of Prior Powers		
<input type="checkbox"/>	Response to Incomplete Appln	<input type="checkbox"/>	Change of Correspondence Address		
<input type="checkbox"/>	Response to Missing Parts	*Extension of Term: Pursuant to 37 CFR 1.136, Applicant petitions the Commissioner to extend the time for response for xxxxxx month(s), from to .			
<input type="checkbox"/>	Executed Declaration by Inventor(s)				

CLAIMS

FOR	Claims Remaining After Amendment	Highest # of Claims Previously Paid For	Extra Claims	RATE	FEE
Total Claims	14	20	0	\$18.00	\$ 0.00
Independent Claims	4	5	0	\$86.00	\$ 0.00
Total Fees					\$ 0.00

METHOD OF PAYMENT

<input checked="" type="checkbox"/>	Check no. 5798 in the amount of \$330.00 is enclosed for payment of fees.
<input type="checkbox"/>	Charge \$ _____ to Deposit Account No. _____ (Account Holder Name) for payment of fees.
<input checked="" type="checkbox"/>	Charge any additional fees or credit any overpayment to Deposit Account No. 02-2120 (Sawyer Law Group LLP)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Attorney Name	Joseph A. Sawyer, Jr., Reg. No. 30,801
Signature	
Date	July 23, 2004

CERTIFICATE OF MAILING

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Type or printed name	Sandra D. Hunter
Signature	



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPEAL NO:

In Re Application of:

Elizabeth G. GIBSON, et al.

Serial No: 09/741,244

Filed: December 19, 2000

For: TELEPHONE SYSTEM INCLUDING VOICE MAIL SCREENING

APPELLANT'S BRIEF

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CERTIFICATE OF MAIL

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Sandra D. Hunter

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Date: July 23, 2004

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For: TELEPHONE SYSTEM INCLUDING VOICE MAIL SCREENING

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

Sir:

Appellant herein files an Appeal Brief drafted in accordance with the provisions of 37

C.F.R. § 1.192(c) as follows:

I. REAL PARTY IN INTEREST

Appellants respectfully submit that the above-captioned application is assigned, in its entirety to SBC Technology.

II. RELATED APPEALS AND INTERFERENCES

Appellants state that, upon information and belief, they are not aware of any co-pending appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Application Serial No. 09/741,244 (the instant application) as originally filed included claims 1-14. Claims 1-14 are pending. Claims 1-14 are on appeal and all applied prospective rejections concerning Claims 1-14 are being appealed herein.

IV. STATUS OF AMENDMENT

All amendments made to the instant application have been entered.

V. SUMMARY OF THE INVENTION

The present invention provides a voice mail screening system that is within a telephone. In accordance with the present invention, the system comprises a switching system for receiving a call from a calling party and a voice mailbox coupled to the switching system for receiving the call if a called party does not answer the call. The system also comprises a telephone for receiving the call from the calling party. The telephone provides a three-way call between the calling party, the called party, and the voice mailbox, where the telephone bridges the call between the calling party and the voice mailbox, and where the telephone is capable of screening the calling party when the calling party is coupled to the voice mailbox. The telephone comprises an algorithm therewithin for causing the telephone to set up the three-way call to allow

for the voice mail screening. The system in accordance with the present invention is simple, easy to use, and easily implemented in existing telephone switching systems.

VI. ISSUES

The issue presented is:

- (1) whether claims 1-14 are unpatentable under 35 U.S.C. § 103(a).

VII. GROUPING OF CLAIMS

Appellants hereby state that claims 1-14 form one group.

VIII. ARGUMENTS

A. Summary of the Applied Rejections

The final office action dated January 16, 2004 rejected claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Varney in view of Cannon et al. (hereinafter "Cannon"). In making the rejection, the Examiner stated:

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Varney (U.S. Patent No. 6,310,939) and in view of Cannon et al. (U.S. Patent No. 6,529,587).

Regarding claim 1, Varney teaches a switching system for receiving a call from a calling party (fig. 1; col. 2, lines 22-25).

Varney further teaches that a voice mail system (VMS) coupled to the switching system for receiving the call if a called party does not answer the call (fig. 1; col. 2, lines 22-25; 'voice mail system (VMS)' reads on the claim 'voice mailbox').

Varney further teaches that a telephone station for the called party for receiving the call from the calling party, and wherein the telephone station for the called party enabling screening the calling party when the calling party is coupled to the VMS (fig. 1; col. 2, lines 56-67, col. 3, lines 1, 2, 33-41; 'telephone station for the called party' reads on the claim 'telephone' and 'VMS' reads on the claim 'voice mailbox').

However, Varney fails to teach, "the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox". Cannon teaches that the telephone provides a three-way call between the calling party, the Subscriber (i.e. calling party), and the voice mailbox, wherein the

telephone connects (i.e. bridges) the call between the calling party and the voice mailbox (fig. 2, col. 5, lines 1-20). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Varney to allow the telephone providing a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox as taught by Cannon. The motivation for the modification is to have doing so in order to provide the called party to listen the calling party.

The Examiner stated the following in response to the previous arguments against these rejections:

Applicant's arguments filed 10/31/03 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1, 5, 8 and 11 have been considered but are moot in view of the new ground(s) of rejection.

In view of the Applicant's remarks, it is agreed that Varney does not teach or suggest the added limitation, "wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox" as disclosed in claims 1, 5, 8 and 11. Thus a new ground of rejection of Varney in view of Cannon is applied below.

The Examiner stated the following in the Advisory Action dated April 9, 2004:

The examiner has thoroughly reviewed applicant's arguments but firmly believes that the cited references to reasonably and properly meets the claims 1-14 limitations. Regarding claims 1, 5, 8 and 11, the applicant argues on page 5, lines 15-18, that Cannon does not teach or suggest a telephone "wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox". The examiner disagreed with this argument. Beacause, Cannon does teach a telephone wherein the telephone provides a three-way call between the calling party, the subscriber (i.e., called party), and the voice mailbox, wherein the telephone connects (i.e., bridges) the call between the calling party and the voice mailbox (fig.2, steps 17, 30, 32, 34, 36, 40; col.5, lines 1-20). Furthermore, Varney does also teach that when the called party goes off hook, he is being connected to the calling party and the voice mailbox and a call bridging occurred between the calling party, the called party and the voice mailbox (col.2, line 56-col.3, line 4). The applicant further argues on page 6, lines 6-8, that the screening capabilities of Cannon are not provided by the called party's telephone but instead provided externally by a remote voice mail system. The examiner again disagreed with this argument. Beacause, it has been already shown in the final rejection mailed on 01/16/04 that Varney teaches the telephone station for the called party (i.e., telephone) enabling screening the called party when the calling party is coupled to the VMS (i.e., voice mailbox) the called party (i.e., telephone) enabling screening the calling party when the calling party is coupled to the VMS (i.e., voice mailbox) (fig.1; col.2, lines 56-67) .

Appellants respectfully request that the Board reverse the Examiner's final rejection of the pending Claims.

B. The Cited Prior Art

Varney discloses a screening and monitoring capability for switch based voice messaging systems that allows a called party to hear the caller and the caller's voice as the caller leaves a message and break in to start a normal telephone discussion if the caller or the caller's subject warrants such action. The method and apparatus of this invention provide for an advanced intelligent network service feature that controls the bridging of the connections to the voice mail and the called party's telephone station. The service feature turns the voice mail off and tears down the connection if the monitoring called party speaks.

Cannon discloses a method for screening an active incoming voice mail message and broadcasts the incoming message in real time on a speaker in or associated with the subscriber's telephone set upon and concurrent with receipt of the same by the voice mail system. Upon detection during the broadcast of an interrupt request provided by the subscriber via the subscriber's telephone set, the calling party is connected with the subscriber, and normal recording of the message by the voice mail system is discontinued.

C. Claims Are Not Unpatentable Under 35 U.S.C. § 103(a)

The present invention provides a voice mail screening system that is within a telephone. In accordance with the present invention, the system comprises a switching system for receiving a call from a calling party and a voice mailbox coupled to the switching system for receiving the call if a called party does not answer the call. The telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call

between the calling party and the voice mailbox, and wherein the telephone is capable of screening the calling party when the calling party is coupled to the voice mailbox. Varney in view of Cannon does not teach or suggest these features, as discussed below.

Applicants agree that Varney fails to teach a telephone, “wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox,” as recited in independent claims 1, 5, 8, and 11. Instead, Varney teaches that an external and remote service node provides a three-way call (Figure 1 and column 2, line 56, to column 3, line 6). According to Varney, the service node (SN) answers the call from the caller and bridges the call to the voice mail system (VMS) if the called party does not answer the call. If the called party wants to listen to the calling party leaving a message, the called party must dial a code making a subsequent call to the SN. The SN then provides a three-way call by bridging the subsequent call from the called party to the VMS (column 2, line 22, to column 3, line 5). Accordingly, the screening capabilities of Varney are not provided by the called party’s telephone but are instead provided externally by a remote service node. In contrast to Varney, the telephone as recited in claims 1, 5, 8, and 11 provides the three-way call without the need for an external service node, making the claimed telephone screening system simple, easy to use, and easily implemented in existing telephone switching systems. Varney does not provide these benefits because the called party’s telephone station of Varney does not provide the screening functionality within the telephone of the present invention.

Applicants respectfully submit that Cannon also does not teach or suggest a telephone, “wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice

mailbox,” as recited in independent claims 1, 5, 8, and 11. Instead, Cannon teaches that a public branch exchange (PBX) or a central switching office provides the three-way call (column 1, lines 33-37, and column 2, lines 29-47). According to Cannon, “screening a voice mail message is typically implemented by using a voice mail system provided, for example, through a PBX telephone system or by a telephone service provider such as a local telephone company or mobile telephone service provider” (column 2, lines 29-35). Furthermore, if the subscriber wants to screen incoming calls, the FLASH hook (connection between the subscriber’s telephone set and the voice mail box)” is identical to the FLASH hook action performed for switching between two calls when using a conventional call waiting service of a service provider” (column 5, lines 1-10). Furthermore, it is the voice mail system that connects the incoming call to the subscriber’s telephone set (column 5, lines 14-18). Accordingly, the screening capabilities of Cannon are not provided by the called party’s telephone but are instead provided externally by a remote voice mail system.

In view of the foregoing, Applicants respectfully submit that the recited invention is not taught, shown, or suggested by the cited art.

Accordingly, Appellants respectfully request withdrawal of the rejection under 35 U.S.C. 103(a) and respectfully requests that the Board reverse the final rejection of Claims.

E. Summary of Arguments

For all the foregoing reasons, it is respectfully submitted that Claims 1-14 (all the Claims presently in the application) are patentable for defining subject matter which would not have been unpatentable under 35 U.S.C. § 103(a) at the time the subject matter was invented. Thus,

Appellants respectfully request that the Board reverse the rejection of all the appealed Claims and find each of these Claims allowable.

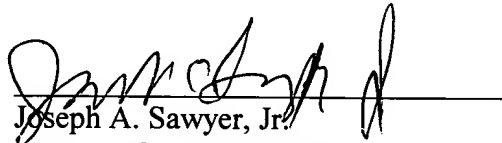
Note: For convenience of detachment without disturbing the integrity of the remainder of pages of this Appeal Brief, Appellants' "APPENDIX" section is contained on separate sheets following the signatory portion of this Appeal Brief.

This Brief is being submitted in triplicate, and authorization for payment of the required Brief fee is contained in the cover letter for this Brief. Please charge any fee that may be necessary for the continued pendency of this application to Deposit Account No.

Respectfully submitted,

SAWYER LAW GROUP LLP

July 23, 2004
Date



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IX. APPENDIX

1. A telephone system comprising:

a switching system for receiving a call from a calling party;

a voice mailbox coupled to the switching system for receiving the call if a called party does not answer the call; and

a telephone for receiving the call from the calling party, wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox, and wherein the telephone is capable of screening the calling party when the calling party is coupled to the voice mailbox.
2. The system of claim 1 wherein the telephone further comprises first and second connections to the switching system, wherein one of the first and second connections is utilized to provide the three-way call.
3. The system of claim 2 wherein the calling party cannot hear the called party during the three-way call.
4. The system of claim 3 wherein the called party can, through interaction with the telephone, talk with the calling party through the other of the first and second connections, and wherein the voice mailbox is dropped from the call.
5. A method for voice mail screening comprising the steps of:
 - (a) receiving a call from a calling party by a voice mailbox; and

(b) joining the called party, the calling party, and the voice mailbox, wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox, and wherein the called party can screen a message from the calling party.

6. The method of claim 5 further comprising the step of (c) preventing the calling party from hearing the called party during the three-way call.

7. The method of claim 6 further comprising the step of (d) dropping the voice mailbox from the three-way call by the telephone when the called party speaks to the calling party.

8. A computer readable medium containing program instructions for voice mail screening, the program instructions for:

(a) receiving a call from a calling party by a voice mailbox; and

(b) joining the called party, the calling party, and the voice mailbox,

wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox, and wherein the called party can screen a message from the calling party.

9. The computer readable medium of claim 8 further comprising the step of (c) preventing the calling party from hearing the called party.

10. The computer readable medium of claim 9 further comprising the step of (d) dropping the voice mailbox from the three-way call by the telephone when the called party speaks to the calling party.

11. A telephone comprising:
a receiver for receiving a call from a calling party; and
a voice mail screening system within the telephone for allowing a called party to hear the calling party when the calling party is coupled to a voice mailbox, wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, and wherein the telephone bridges the call between the calling party and the voice mailbox.

12. The telephone of claim 11 wherein the telephone further comprises first and second connections to the switching system, wherein one of the first and second connections is utilized to provide the three-way call.

13. The telephone of claim 12 wherein the calling party cannot hear the called party during the three-way call.

14. The telephone of claim 13 wherein the calling party can, through interaction with the telephone, talk with the calling party through the other of the first and second connections, and wherein the voice mailbox is dropped from the call.